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| EXAMINER |
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OSMAN, RAMY M

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| ART UNIT | PAPER NUMBER |
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2157

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09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,898

Applicant(s)

GRAHAM ET AL.

Examiner

Ramy M. Osman

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is responsive to application filed on July 9, 2007, where applicant amended claims 1,4,8,9,12,14-20, and cancelled claims 2,13. Claims 1,3-12,14-22 are pending.

Drawings

2. The drawings filed on 6/27/2003 are acknowledged and are acceptable. Previous objection to the drawings is withdrawn.

Response to Amendment

3. The 101 non-statutory rejection is withdrawn from claims 12 & 19 in view of the amendments.
4. The 112 second paragraph rejection is withdrawn from claims 4 & 15.
5. Applicant's amendments filed on 7/9/2007 and Applicants arguments in view of said amendments have been fully considered and are found to be persuasive. The previous rejections are withdrawn. However, a new grounds of rejection is presented below, in light of the amended claims, and based upon newly found art presented below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2157

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1,5,6,8,10,12,16,17,19,21 rejected under 35 U.S.C. 102(e) as being anticipated by DiSanto et al (US Patent No 6,856,686).**

8. In reference to claim 1, DiSanto teaches a rights-managed email for sending protected content from a sender to a recipient, whereby the recipient can render the protected content with a corresponding license if the recipient satisfies terms set forth in the license, the email comprising:

a main information portion having a message that the email is rights management protected; and an attachment portion having the protected content (column 12 lines 53-63 & column 13 lines 30-35)

and comprising rights data relating to the protected content, the rights data setting forth each entity that has rights with respect to the protected content, and for each such entity a description of such rights (column 13 line 62 – column 14 line 29),

wherein the recipient if enabled can render the protected content in the attachment portion and if not enabled can only review the main information portion having the message (column 12 lines 39-48 and column 13 lines 30-35).

9. In reference to claim 5, DiSanto teaches the email of claim 1 wherein the protected content in the attachment portion comprises multiple alternative forms of a body of the email, whereby the recipient can select from among the alternative forms when rendering the protected content (column 13 line 62 – column 14 line 29).

Art Unit: 2157

10. In reference to claim 6, DiSanto teaches the email of claim 1 wherein the protected content in the attachment portion comprises a body and an attachment list, the attachment list including preface information, at least one attachment to the body, and any metadata relating to each attachment of the body (column 13 line 62 – column 14 line 29).

11. In reference to claims 12,16,17, these claims teach a system that correspond to the method claims of claims 1,5,6. Therefore, claims 12,16,17 are rejected based upon the same rationale as given for the rejections of claims 1,5,6.

12. In reference to claims 8,10 & 19,21, these claims teach a method and computer readable medium respectively, that correspond to the method claims of claims 1,5,6. Therefore, claims 8,10 & 19,21 are rejected based upon the same rationale as given for the rejections of claims 1,5,6.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 3,4,7,9,11,14,15,18,20,22 rejected under 35 U.S.C. 103(a) as being unpatentable over DiSanto et al (US Patent No 6,856,686) in view of Beck et al (US Patent No 5,903,723).**

15. In reference to claim 3, DiSanto teaches the email of claim 2. Although DiSanto teaches various content security methods (column 9 lines 57-67), DiSanto fails to explicitly teach

Art Unit: 2157

wherein the protected content in the attachment portion is encrypted according to a cryptographic key, and the rights data includes a decryption key (KD) for decrypting the encrypted content.

However, Beck teaches transmitting an attachment that is encrypted along with its decryption key for the purpose of securing the attachment so that only the intended recipient can render the attachment (column 7 lines 19-40). It would have been obvious for one of ordinary skill in the art to modify DiSanto wherein the protected content in the attachment portion is encrypted according to a cryptographic key, and the rights data includes a decryption key (KD) for decrypting the encrypted content as per the teachings of Beck for the purpose of securing the attachment so that only the intended recipient can render the attachment.

16. In reference to claim 4, DiSanto teaches the email of claim 3. Although DiSanto teaches various content security methods (column 9 lines 57-67), DiSanto fails to explicitly teach wherein the decryption key (KD) is encrypted according to a public key of a rights management (RM) server (PU-RM) operated by or on behalf of an organization of the sender to result in (PU-RM(KD)), where only the RM server can access (KD) from (PU-RM(KD)) with a corresponding private key (PR-RM). However, Beck teaches utilizing v encryption techniques including encrypting the decryption key according to a public key for the purpose of securing the attachment so that only the intended recipient can render the attachment (column 7 lines 19-40). It would have been obvious for one of ordinary skill in the art to modify DiSanto wherein the decryption key (KD) is encrypted according to a public key of a rights management (RM) server (PU-RM) operated by or on behalf of an organization of the sender to result in (PU-RM(KD)), where only the RM server can access (KD) from (PU-RM(KD)) with a corresponding private

Art Unit: 2157

key (PR-RM) as per the teachings of Beck for the purpose of securing the attachment so that only the intended recipient can render the attachment.

17. In reference to claim 7, DiSanto teaches the email of claim 1. DiSanto fails to explicitly teach wherein the protected content in the attachment portion is compressed to reduce an overall size thereof. However, Beck teaches compressing attachments for the purpose of minimizing storage space for transmitting to a recipient (column 6 lines 37-50). It would have been obvious for one of ordinary skill in the art to modify DiSanto wherein the protected content in the attachment portion is compressed to reduce an overall size thereof as per the teachings of Beck for the purpose of minimizing storage space for transmitting to a recipient.

18. In reference to claims 14,15,18, these claims teach a system that correspond to the method claims of claims 3,4,7. Therefore, claims 14,15,18 are rejected based upon the same rationale as given for the rejections of claims 3,4,7.

19. In reference to claims 9,11 & 20,22, these claims teach a method and computer readable medium respectively, that correspond to the method claims of claims 3,4,7. Therefore, claims 9,11 & 20,22 are rejected based upon the same rationale as given for the rejections of claims 3,4,7.

Conclusion

20. The claims have been given their broadest reasonable interpretation. Applicant is advised that the above specified citations of the relied upon prior art are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and priority documents) is implied as being applied to teach the scope of the claims.

Art Unit: 2157

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO

September 15, 2007


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